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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,325	11/04/2003	Mark W. Brockman	68.0114CIP/DIV	4937

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EXAMINER	
KRECK, JOHN J	

ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/701,325	BROCKMAN ET AL.	
	Examiner	Art Unit	
	John Kreck	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/11/05*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21 and 25* is/are rejected.

7)☒ Claim(s) *22-24,26 and 27* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment dated 3/11/05 has been entered.

Claims 1-27 are pending.

Claim Objections

1. Claims 22-24 are objected to because of the following informalities: these new claims use the term "second" and "third inductive coupler portions" in a manner which appears to be inconsistent with existing claims 4 and 5, for example. It is suggested that applicant scrutinize the claims so that these terms are used consistently. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tubel, et al. (U.S. Patent number 5,959,547) in view of More, et al. (U.S. Patent number 5,008,664).

Tubel teaches the well having a main bore and a lateral branch; and also teaches the electrical signaling between the main bore and equipment in the lateral branch. Tubel fails to teach the inductive coupler.

More teaches a downhole communication system comprising inductive couplers. More teaches that the inductive couplers are beneficial because they simplify handling of downhole tools, and provide for reliable communication.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Tubel system to have an inductive coupler as called for in claim 1; in order to simplify handling of downhole tools, and provide for reliable communication.

Regarding independent claim2:

Tubel teaches the well having a main bore and a lateral branch and the connector mechanism; and also teaches the electrical signaling between the main bore and equipment in the lateral branch. Tubel fails to teach the inductive coupler.

More teaches a downhole communication system comprising inductive couplers. More teaches that the inductive couplers are beneficial because they simplify handling of downhole tools, and provide for reliable communication.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Tubel system to have an inductive coupler as called for in claim 2; in order to simplify handling of downhole tools, and provide for reliable communication.

More teaches the electrical cable as called for in claim 3.

With regards to claims 4-7; Tubel teaches communication to multiple bores, thus it would have been obvious to one of ordinary skill in the art at the time of the invention

to have further modified the Tubel system to have included second, third, and fourth inductive coupler portions.

Regarding independent claim 8:

Tubel teaches the well having a main bore and a lateral branch; equipemtn in the main bore and branch; and also teaches the electrical signaling between the main bore and equipment in the lateral branch. Tubel fails to teach the inductive coupler.

More teaches a downhole communication system comprising inductive couplers. More teaches that the inductive couplers are beneficial because they simplify handling of downhole tools, and provide for reliable communication.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Tubel system to have an inductive coupler as called for in claim 8; in order to simplify handling of downhole tools, and provide for reliable communication.

With regards to claims 9 and 10; Tubel teaches communication to multiple bores, thus it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the Tubel system to have included second and third inductive coupler portions.

Tubel shows the tubing as called for in claim 11.

Tubel teaches the electrical device as called for in claim 12.

Tubel teaches the monitoring module as called for in claim 13.

Tubel teaches the control module as called for in claim 14.

Tubel teaches the casing ("well" in fig. 3) and window as called for in claim 15.

With regartds to claims 16 and 17: Tubel fails to clearly show the communication path, however it is apparent that the wiring would travel from the tubing to the connector and then to the lateral bore equipment; thus it would have been obvious to one of ordinary skill in the art at the time of the invention to have the coupler portions attached to the tubing and connector as called for in claim 16; and to the connector and lateral branch equipment as called for in claim 17.

Regarding independent claim 20:

Tubel teaches a method of communicating including transmitting signaling between main bore equipment and lateral branch equipment. Tubel fails to teach the inductive coupler.

More teaches a downhole communication system comprising inductive couplers. More teaches that the inductive couplers are beneficial because they simplify handling of downhole tools, and provide for reliable communication.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Tubel system to have an inductive coupler as called for in claim 20; in order to simplify handling of downhole tools, and provide for reliable communication.

More teaches the providing a second coupler and electrically connecting as called for in claim 21.

With regards to claim 25, the Tubel reference teaches the connector having a receptacle; it would have been obvious to one of ordinary skill in the art at the time of the invention to have placed the inductive coupler so that the connector would have a portion as called for in claim 25.

2. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tubel and More as applied to claim 8 above, and further in view of Pringle, et al. (U.S. Patent number 5,542,472). Tubel and More fails to teach the hydraulic control line.

Pringle teaches that hydraulic control lines can be used alongside electrical signaling; in order to control hydraulic tools downhole.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the Tubel system to have included hydraulic control in order to operate hydraulic devices.

Response to Arguments

3. Applicant's arguments filed 3/11/05 have been fully considered but they are not persuasive.

Applicant has argued that there is no motivation to combine the Tubel and More references; the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, More clearly teaches the advantages of inductive coupling (col. 1, lines 15-27).

Applicant has argued that there is no teaching to make the first coupler portion "attached to the connector mechanism" as called for in claim 2. This is not at all persuasive. Everything in the wells shown by Tubel and More are "attached"; thus one of ordinary skill in the art would know to make any modification "attached": to do otherwise would result in the components being swept along with flow, lost, or damaged.

Applicants arguments concerning claims 22 and 26 are persuasive: the prior art of record fails to disclose or suggest the combination including the tubing having a lower portion with a inductive coupler portion and the connector having a receptacle and inductive coupler to receive the tubing.

With regards to claim 8; it is noted that the term "equipment" is very broad, it is readily apparent that the Tubel well shows "equipment" throughout the main and lateral bores; thus location of couplers anywhere would make them "proximal" at least some equipment.

Allowable Subject Matter

4. Claim22-24 and 26-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is 571-272-7042. The examiner can normally be reached on M-F 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 571-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN KRECK
PRIMARY EXAMINER

John Kreck
Primary Examiner
Art Unit 3673

7 June 2005